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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,468	09/19/2006	Huminori Ikeda	Q97089	2775
23373	7590	04/28/2009	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			DUCHENEAUX, FRANK D	
			ART UNIT	PAPER NUMBER
			1794	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/593,468	<b>Applicant(s)</b> IKEDA ET AL.	
	<b>Examiner</b> FRANK D. DUCHENEAUX	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/19/2006; 4/20/2007</u> .                                    | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Specification*

1. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract **should not refer to purported merits or speculative applications** of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

2. The abstract of the disclosure is objected to because the last sentence refers to the purported merits of the present invention. Correction is required. See MPEP § 608.01(b).

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3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Objections*

4. **Claim 4** is objected to because of the following informalities: The last line of said claim should read, "according to claim 1." Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 1-4** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Regarding claims 1-2**, the recitation of the ranges of a modulus of elasticity is indefinite as the claims provide no temperature limitations.

**Regarding claim 3**, the recitation of "in such a way" renders the claim indefinite as there are provided no further limitations (i.e., composition, thickness, etc.) so as to make clear the "way"

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in which the limitations provided are "arranged." Additional, the claim fails to recite a thickness of said film, which would inherently affect the transmittance of a range of wavelengths of light, and as such, the claim is indefinite.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1-3** are rejected under 35 U.S.C. 102(b) as being anticipated by Sugino et al. (JP 2003-313330 A). The examiner notes that a machine translation, provided with the present Office Action, was employed to translate passages from the ~330 reference. The examiner's word terminology was taken directly from the machine translation and/or from an oral translation with a STIC representative (see search notes included with the present Office Action).

**Regarding claims 1-3**, Sugino teaches a substrate film (surface substrate film) with a tensile elastic modulus of from 300 – 900 MPa (para 0019) and a thickness ranging from 40 to 200  $\mu\text{m}$  (para 0029) made from a polyolefin resin (para 0013). Sugino also teaches a substrate film containing an ultraviolet ray absorbent (para 0020), said ultraviolet ray absorbent is a benzotriazole (para 0022, lines 1-2) in about 0.05 - 5 weight parts to 100 weight parts of the polyolefin (para 0023, lines 6-12). The examiner notes that the reference teaches the same class of compounds (i.e., a benzotriazole) as used in the present invention and as such, the

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benzotriazole compounds and the thickness ranges of said substrate film as disclosed by the reference would inherently provide a transmittance percentage at a given wavelength or range of wavelengths as in the present invention.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. **Claims 3-4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugino et al. (JP 2003-313330 A) in view of Endo et al. (US 6872447 B1) and in light of the evidence as provided by Petrie (*Handbook of Adhesives and Sealants*).

**Regarding claim 3-4**, Sugino teaches a substrate film as in the rejection of claim 1 above.

Sugino also teaches a film with an adhesion layer (para 0061, lines 2-4) and that the kind of adhesive is a crude rubber, a synthetic rubber, an acrylic, a urethane system, etc. and the form

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may further be any including a solution type, an emulsion type and a hot melt type (para 0062, lines 1-7). Sugino fails to teach an ultraviolet absorber in a proportion of 0.01 to 20 parts by mass relative to 100 parts by mass of a surface substrate film in such a way that the spectral transmittance of the surface substrate film in a wavelength region from 200 to 380 nm falls within a range from 0 to 20 %; and a substrate film comprising a pressure-sensitive adhesive layer on one surface of the surface substrate film.

However, Endo teaches a surface-protective pressure-sensitive adhesive sheet comprising a three-layered film comprising layers A, B and C laminated (substrate) in this order and a pressure-sensitive adhesive layer on C (on one surface), wherein layer A contains a polyethylene (column 1, lines 51-56), and wherein layer A contains an ultraviolet absorber in an amount of 0.05 to 0.5 % by weight based on the total weight of the layer A (column 2, lines 17-21). The examiner notes that the lower range and upper ranges as claimed in the present invention demonstrates a % weight range of,

$$\frac{0.01}{100} \times 100 = 0.01\%$$

to

$$\frac{20}{100} \times 100 = 20\%$$

from which it is clear that the amount of UV absorber in the reference falls squarely within the amounts presently claimed. Endo also teaches the ultraviolet stabilizer is Tinuvin 326, which is identical to stabilizer used in the present invention (column 6, lines 10-11). Endo continues to teach a thickness of layer A is 2 to 200  $\mu\text{m}$  (column 4, lines 65-66). The examiner notes that it

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would have been obvious to one of ordinary skill in the art at the time of the invention to adjust the thickness of a substrate film containing UV blockers towards a film with a specified transmittance percentage at a given range of wavelengths in order to mitigate damaging effects of said wavelengths while maintaining the other utilities of a substrate film since it has been held that discovering an optimum value of a result-effective variable involves only routine skill in the art (*In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)). Endo finally teaches said pressure-sensitive adhesive sheet has excellent weathering resistance to undergo neither chalking nor fracture in the substrate at peeling, even after prolonged outdoor exposure, which develops less corona odor to enable extended operation of applying it, and which can be manufactured inexpensively with reduced manufacturing process (column 1, lines 7-13). In addition to Endo, Petrie teaches advantages to pressure-sensitive adhesives including flexibility, tack and peel strength (section, 8.2.3.2.2, lines 15-16) as well as those advantages listed in Table 8.6 on page 302.

With respect to claim 4, while there is no disclosure that the substrate film of Sugino and the surface-protective pressure-sensitive adhesive sheet of Endo is a motor vehicle brake disc antirust film as presently claimed in claim 4, applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended



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use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. motor vehicle brake disc antirust film, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art of Sugino in view of Endo and further that the prior art structure which is a substrate film with a pressure sensitive adhesive as presently claimed is capable of performing the recited purpose or intended use.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the substrate film as taught by Sugino with a specific film thickness and Tinuvin 326 ultraviolet stabilizer and additionally layered with a pressure-sensitive adhesive layer as taught by Endo towards a substrate film capable of being attached to a surface and being capable of blocking the damaging rays of ultraviolet light in order to protect a surface to be protected via application of the substrate film; and further towards a product with the inherent advantages – cost-effectiveness, flexibility, tack, peel strength, etc. - of a pressure sensitive adhesive as in the present invention.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK D. DUCHENEAUX whose telephone number is (571)270-7053. The examiner can normally be reached on M-Th, 7:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie E. Shosho can be reached on (571)272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FDD

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1794